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DOCKET NO. 01-C-055 (STMI01-01055)
Customer No. 30425

3725

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : HARRY MICHAEL SIEGEL, ET AL.

Serial No. : 10/062,595

Filed : January 31, 2002

For : SYSTEM AND METHOD FOR ALIGNING AN
INTEGRATED CIRCUIT DIE ON AN INTEGRATED
CIRCUIT SUBSTRATE

Group No. : 3725

Examiner : David B. Jones

MAIL STOP NON-FEE AMENDMENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

A Restriction Requirement was mailed in the present patent application on February 20, 2004 with time period for response ending on March 20, 2004. Because March 20, 2004 is a Saturday, the time period for response is extended to Monday, March 22, 2004.

In response to the Restriction Requirement, the Applicants provisionally elect the claims of Group II, Claims 13-22, WITH TRAVERSE.

The Restriction Requirement characterizes Claims 1-12 (Group I) as drawn to "a stamping tool" and Claims 13-22 (Group II) as drawn to "a method of aligning an integrated circuit on a substrate." (Restriction Requirement, Page 2). The Applicants respectfully

submit that the Restriction Requirement provides no factual basis for asserting either independence or distinctness of these claims. The Restriction Requirement makes the following statements:

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another an materially different process (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus not requiring the particulars of the tool of group I. (Restriction Requirement, Page 2, Paragraph 2).

A restriction requirement must provide the particular factual basis for asserting that restriction is necessary:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. (MPEP § 816, p. 800-56 (8th ed. rev. 1 February 2003)).

The Restriction Requirement fails to provide such a factual basis (as opposed to a “mere statement of conclusion”) indicating why the claims recite patentably distinct species--that is, a factual basis for asserting that: “the process as claimed can be practiced by another materially different apparatus not requiring the particulars of the tool of group I.” The Examiner does not identify “another materially different apparatus” that does not have the particulars of the stamping tool claimed in Claims 1-13.

The Applicants respectfully traverse the Examiner's conclusion for the following reasons. Restriction is only proper where the claims are independent or distinct. MPEP § 806. In passing on questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01, p. 800-39. The Restriction Requirement concedes that the claims are not independent but are related ("Inventions II and I are related as process and apparatus for its practice").

Claim 1 is directed to a stamping tool as follows:

1. A stamping tool comprising:
a stamp capable of imprinting at least one deposit of deformable material on an integrated circuit substrate;
wherein said stamping tool is capable of aligning a position of said stamp with respect to at least one tooling hole in said integrated circuit substrate.

Claim 13 is directed to a method that requires the use of the tool claimed in Claim 1:

13. A method for aligning an integrated circuit die on an integrated circuit substrate, the method comprising the steps of:
placing a plurality of deposits of deformable material on said integrated circuit substrate where said integrated circuit die is to be attached to said integrated circuit substrate;
placing a stamping tool into at least one tooling hole within said integrated circuit substrate;
imprinting said plurality of deposits of deformable material with said stamping tool; and
placing said integrated circuit die into a pocket formed in said plurality of deposits of deformable material.

From the foregoing, the Applicants respectfully submit that it is clear that only a "stamping tool" of the type claimed in Claim 1 can perform the method as claimed in Claim 13.

That is, there is not “another materially different apparatus” that can perform the method of the invention as claimed in the Group II claims. Therefore, the Restriction Requirement accordingly has failed to establish that the process as claimed in Claims 13–22 could be practiced by another materially different apparatus than the apparatus as claimed in Claims 1–12.

With regard to the assertion that “the search required for Group I is not required for Group II”, the Restriction Requirement fails to provide any factual basis for such conclusion.

With respect to distinctness of Claims 1–12 from Claims 13–22, the Restriction Requirement fails to satisfy any of the requirements for restricting the claims of the patent application. Accordingly, the Applicants respectfully request that the restriction be withdrawn.

SUMMARY


If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

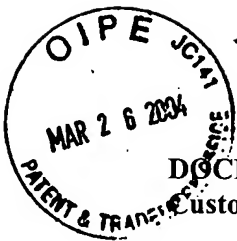
DAVIS MUNCK, P.C.

Date: March 22, 2004



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CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Sir:

The undersigned hereby certifies that the following documents:

1. Response to Restriction Requirement; and
2. A postcard receipt;

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to MAIL STOP NON-FEE AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 22, 2004.

Date: 3/22/04

Ruthy Cedar
Mailer

Date: March 22, 2004

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